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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/135,034	08/17/98	MCMILLAN R	PGR2001-1

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EXAMINER
COSIMANO, E

ART UNIT	PAPER NUMBER
2761	6

DATE MAILED: 03/18/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/135,034

Applicant(s)
McMillan et al

Examiner
EDWARD COSIMANO

Group Art Unit
2761



☒ Responsive to communication(s) filed on Aug 8, 1998 and Dec 28, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire THREE month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 21-40 is/are pending in the application.

Of the above, claim(s) none is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 21-40 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☒ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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1. Applicant should note the changes to patent practice and procedure effective December 01, 1997 as published in the Federal Register, Vol 62, No. 197, Friday October 10, 1997.
2. As originally filed on August 17, 1998, the instant application contained claims 1-20. At the time of filing applicant canceled claims 1-27(20), note point 5 of the cover letter filed August 17, 1998), hence claims 28-34 filed August 17, 1998 have been renumber as claims 21-27 in accordance with 37 CFR 1.126. It is further noted that claims 35-47 filed December 28, 1998 have been renumber as claims 28-40 in accordance with 37 CFR 1.126.

§ 1.126 Numbering of claims.

The original numbering of the claims must be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When claims are added, except when presented in accordance with § 1.121(b), they must be numbered by the applicant consecutively beginning with the number next following the highest numbered claim previously presented (whether entered or not). When the application is ready for allowance, the examiner, if necessary, will renumber the claims consecutively in the order in which they appear or in such order as may have been requested by applicant. [32 FR 13583, Sept. 28, 1967]

3. The disclosure is objected to because of the following informalities:

A) applicant must update:

- (1) the continuing data on page 1,

with the current status of each of the referenced applications, e.g., --now abandoned--, or --now patent #?--, or --which is abandoned and now serial number #?--, etc.

B) the specification lacks an explicit reference to the nature of:

- (1) reference legend(s):

- (a) 112 & 114 of fig. 1; and

- (2) how the program proceeds after box(es):

- (a) 108 of fig. 1 if the inquiry is "NO";

- (b) 110 of fig. 1 if the inquiry is either "YES" or "NO"; and

- © 512 of fig. 5 if the inquiry is "NO";

as required by 37 CFR § 1.84(p(5)). It is noted that merely mentioning a number with out mentioning the device or operation of the step relies on the drawing to provide support for

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the disclosure and not to aid in the understanding of the invention, as is the purpose of the drawings (37 CFR § 1.81(a,b)).

C) the following errors have been noted in the specification:

(1) the specification lacks a statement of --We claim:--, (see MPEP 608.01(m)).

Appropriate correction is required.

4. The specification and drawings have not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification or drawings. Applicant should note the requirements of 37 CFR § 1.74, § 1.75, & § 1.84(o,p(5)).

5. The amendment filed August 17, 1998 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the amendment to page 10, line 24. Applicant is required to cancel the new matter in the reply to this Office action.

5.1 The amendment filed December 28, 1998 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the amendment to page 13, line 30. Applicant is required to cancel the new matter in the reply to this Office action.

6. The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6.1 The specification is objected to under 35 U.S.C. § 112, first paragraph, as:

A) the specification, as originally filed, does not provide support for the invention as now claimed.

6.1.1 The specification as originally filed does not provide support for the amendments to:

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- A) page 10, line 24 (filed August 17, 1998);
- B) page 13, line 30 (filed December 28, 1998);
- C) the subject matter of claim 39, lines 6-8; and
- D) the subject matter of claim 40, lines 4-5;

and hence the corresponding subject matter recited in claims 27, 35, 36, 39 & 40.

6.1.2 Claims 27, 35, 36, 39 & 40 are rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification.

7. Claims 27, 35, 36, 39 & 40 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7.1 Since applicant is claiming subject which is not within the scope of the original disclosure, applicant has failed to particularly point out and distinctly claim what is regarded as the invention.

7.2 For the above reason, applicant has failed to particularly point out what is regarded as the invention.

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper time wise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

8.1 A timely filed terminal disclaimer in compliance with 37 CFR 1.321[©] may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

8.1.1 Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8.2 Claims 21-26, 28-34, 37 & 38 are rejected under the judicially created doctrine of double patenting over claims 1-26 of U. S. Patent No. 5,797,134 since the claims, if allowed, would

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improperly extend the "right to exclude" already granted in the patent.

8.2.1 The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: subject matter of claims 21-26, 28-34, 37 & 38 of the instant application are also claimed in at least claims 1, 12, 16 & 22 of U. S. Patent No. 5,797,134.

8.2.2 Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(c) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371^c of this title before the invention thereof by the applicant for patent.

9.1 Claims 21-24, 28, 29, 33 & 34 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Camhi et al (5,430,432) or Ousbourbe (5,499,182).

9.1.1 In regard to claims 21-24, 28, 29, 33 & 34, either Camhi et al ('432) or Ousbourbe ('182) disclose a system which collect operational data about a vehicle. The data is then analyzed to determine if a trigger event of some type has occurred. When a trigger event has occurred, then the monitored operational data is stored in a different storage unit for further analysis.

10. Art of interest, which discloses monitoring and recording systems, is cited by the examiner.

11. The shorten statutory period of response is set to expire 3 (three) months from the mailing

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date of this Office action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Cosimano whose telephone number is (703) 305-9783. The examiner can normally be reached Monday through Thursday from 7:30am to 6:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Todd Voeltz, can be reached on (703)-305-9714. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3800.

12.1 The fax phone number for **UNOFFICIAL FAXES** for this group is (703) 305-0040.

12.2 The fax phone number for **OFFICIAL FAXES** for this group is either (703) 308-9051 or (703) 308-9052.

03/13/99


Edward R. Cosimano

Primary Examiner A.U. 2761